

REMARKS

Status of the claims

Claims 1-22 are currently pending. Claim 1 has been amended to correct certain grammatical errors; to delete the term "carriers;" to amend the definition of A to require A to be $(CH_2)_2$ (optionally substituted as claimed); to require that B must be substituted with one or more substituents; to delete the definitions of W, m, n, and p; to require that R^2 cannot be hydrido; and to delete the proviso (which was rendered moot by the other amendments to claim 1). Claims 2, 3, and 7 have been cancelled. Claims 4, 6, 8, and 13 have been amended to correct their dependencies. Claims 11 and 12 have been amended to delete compounds outside the scope of amended claim 1. No new matter has been added by these amendments, and as amended, claims 1-13 are still within the scope of elected Group I.

Claim 14 stands withdrawn, but has been amended to correct its dependency (in light of the Office's comments on page 3 of the Office action). Claims 15-22 stand withdrawn as drawn to non-elected species. Applicants reserve their right to rejoin withdrawn claims 14-22 upon allowance of the pending composition claims.

Claims 1-13 stand rejected under §112, second paragraph and under §103(a) as unpatentable over Callahan et al., WO 03/086309 ("Callahan") and Bastian, U.S. Patent No. 4,183,943 ("Bastian"). Claims 1, 2, 4, 8, and 9 stand rejected under §102(a) as unpatentable over compounds identified as Compound a through Compound ai in the Office action. Claims 1-4, 11, and 13 stand rejected under §102(b) as independently unpatentable over Rosowsky et al., *J. Med. Chem.*, 16(3), 1973, 191-194 ("Rosowsky"), Elslager et al., *J. Hetero. Chem.*, 9(4), 1972, 775-782 ("Elslager"), and Bastian. Claims 1, 2, and 4-13 stand rejected under §102(e) as unpatentable over Callahan.

35 U.S. C. §112, second paragraph rejection

Reconsideration is respectfully requested of the rejection of claims 1-13 under §112, second paragraph as being indefinite. Claims 1 and 12 have been amended as proposed by the Office, thereby obviating this rejection.

35 U.S. C. §102(a) rejection

Reconsideration is respectfully requested of the rejection of claims 1, 2, 4, 8, and 9 under §102(a) as unpatentable over compounds identified as Compound a through Compound ai in the Office action. In claim 1 as amended, R^2 cannot be cyano, and thus claim 1 is

patentable over Compounds a-d, i-k, and r-ac. In addition, in claim 1 as amended, B must be substituted by at least one substituent, and thus claim 1 is patentable over Compounds e-h, l-s, and ad-ai.

35 U.S. C. §102(b) rejections

Reconsideration is respectfully requested of the rejection of claims 1-4, 11, and 13 under §102(b) as independently unpatentable over Rosowsky, Elslager, and Bastian. As noted above, in claim 1 as amended, R² cannot be cyano, and thus claim 1 is patentable over Rosowsky and Elslager, and B must be substituted by at least one substituent, and thus claim 1 is patentable over Bastian.

35 U.S. C. §102(e) rejection

Reconsideration is respectfully requested of the rejection of claims 1, 2, and 4-13 under §102(e) as unpatentable over Callahan. Only four of the compounds described by Callahan were also described in the document from which Callahan claims priority (U.S. Provisional App. No. 60/371,946, a copy of which is enclosed for the Office's convenience): Ex. 1 (also Ex. 1 in the '946 provisional); Ex. 2 (Ex. 2 in the '946 provisional); Ex. 4 (Ex. 3 in the '946 provisional); and Ex. 6 (Ex. 4 in the '946 provisional). None of the other compounds disclosed by Callahan were described in the '946 provisional, and thus these compounds are not entitled to the priority date, and are therefore not prior art against the instant application.

None of the four compounds entitled to the priority date of the '946 provisional are within the scope of claim 1, as amended, and therefore claims 1-13 are not anticipated by Callahan.

35 U.S. C. §103(a) rejection

Reconsideration is respectfully requested of the rejection of claims 1-13 under §103(a) as unpatentable over Callahan and Bastian, each taken alone or in combination with each other.

A rejection under §103(a) requires, *inter alia*, that the cited references describe every element of the claimed invention. See MPEP 2143.03. The Office has failed to set out a *prima facie* case of obviousness of claims 1-13. Neither Callahan nor Bastian, taken separately or together, describe every element of the claims. Specifically, neither Callahan nor Bastian describe a compound within the scope of claim 1 (with respect to Callahan, none of the compounds entitled to the priority date of the '946 provisional are within the scope of claim 1).

Conclusion

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The Applicants submit that the present invention is now in condition for allowance. Early allowance of all pending claims is respectfully solicited.

Respectfully submitted,



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Enclosures:

Transmittal Letter
Combined Amendment Transmittal and
Request for Extension of Time
Itemized Postcard
Copy of U.S. Prov. Pat. App. 60/371,946